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**Notice of Allowability**

Application No.

10/688,068

Applicant(s)

DUKESHERER ET AL.

Examiner

John F. Ramirez

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/12/07.
2. ☒ The allowed claim(s) is/are 11, 13-16, 19, 28, 30-33, 38-42, 45-50 and 52-55.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application  |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date <u>20071116</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>6/26/07</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment  |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                  | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance                                    |
|   | 9. <input type="checkbox"/> Other _____  |

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Michael Taylor on November 19, 2007.

The Application has been amended as follows:

I. Claim 28, has been amended to insert the subject matter from claim 29, after the word "anatomy" at the end of the last paragraph of the claim, in line 17. "wherein said body portion further defines a recess within the volume to receive the navigation portion; wherein the navigation portion is operable to be selectively positioned in the recess through a passage through the outside surface; wherein the navigation portion is operable to be removed from the recess during imaging of the anatomy to assist in eliminating any distortion that may be caused by the navigation portion".

II. Claims 18, 20, 29, 34-37 and 44 have been cancelled.

III. Claims 30 and 31 have been amended to correct claim dependency by replacing the word "Claim 29" with "Claim 28".

The following is an examiner's statement of reasons for allowance:

The prior art of record does not disclose or suggest, *inter alia*, in a surgical navigation system a substantially minimally invasive dynamic reference frame for dynamically referencing portions of an anatomy, comprising: a body portion

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selectively attachable to a portion of the anatomy, the body portion having a sidewall defining an exterior perimeter defining an interior portion and a passage through the sidewall into the interior portion; a navigation portion to at least one of sense, transmit, or combinations thereof a characteristic operable to pass through the passage defined by the sidewall and be positioned in the interior portion; and a holding section to hold said body portion relative to the portion of the anatomy; wherein said holding section substantially non-invasively holds said body portion relative to the portion of the anatomy; wherein the navigation portion is operable to be selectively positioned in the interior portion through the passage through the sidewall.

Concerning the section 102(b) rejection using Barrick et al., the examiner agrees with applicant in that the cited reference does not teach or suggest a navigation portion to at least one of sense, transmit, or combinations thereof a characteristic operable to pass through the passage defined by the sidewall and be positioned in the interior portion; and wherein the navigation portion is operable to be selectively positioned in the interior portion through the passage through the sidewall.

Concerning the 103(a) rejection, since Barrick et al., does not disclose all the elements of the pending independent claims, the rejection is considered improper and is hereby withdrawn. Based on the above observations, claims 11, 13-16, 19, 28, 30-33, 38-40, 41-42, 45-50, and 52-55 are allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should

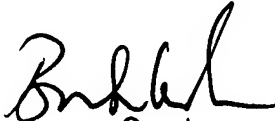
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preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John F. Ramirez whose telephone number is (571) 272-8685. The examiner can normally be reached on (Mon-Fri) 7:00 - 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Brian Casler  
SPS 3737

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